

REMARKS

Applicants respectfully request that the foregoing amendments be entered at least because they do not raise any new issues requiring further search or consideration, and/or because they narrow the issues for appeal.

Claims 6, 15 and 24 are requested to be cancelled.

Claims 1, 10 and 19 are currently being amended.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 3-5, 7-10, 12-14, 16-19, 21-23 and 25-27 are now pending in this application.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 3-10, 12-19 and 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,818,842 (“Burwell”) in view of U.S. Patent No. 6,256,314 (“Rodrig”). In response, without agreeing or acquiescing to the rejection, Applicants have cancelled claims 6, 15 and 24 and amended independent claims 1, 10 and 19 to include the limitations of claims 6, 15 and 24 respectively. Further, Applicants respectfully traverse the rejection for the reasons set forth below.

Applicants rely on MPEP § 2143.03, which requires that all words in a claim must be considered in judging the patentability of that claim against the prior art. Here, the cited references do not identically disclose, teach or suggest all the claim limitations. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Amended independent claims 1, 10 and 19 are directed to an ATM bridge device and a loop detecting method. For example, claim 1 is directed to an ATM bridge device, comprising, in combination with other elements, a packet scrapping judging unit that “if said

transmitter address of said packet input from said ATM network and information about said transmission path through which said packet had been transmitted are matched with said transmitter address of said packet learnt by said second learning unit and information about said transmission path to which said packet is to be output,” is configured “to scrap said packet,...wherein, when a packet is transmitted by a broadcast method from a first device on said layer 2 network side to a device on said ATM network side, a loop-back transmission mode is set to said packet to be received by a second device on said ATM network side.” Independent claims 10 and 19 recite similar limitations.

Accordingly, the device and method claimed in claims 1, 10 and 19 can detect the formation of a loop in an ATM bridge transmission. The ATM bridge device can then remove unwanted ATM network traffic produced by a loop and identify a point in the network where a loop has been formed.

In contrast, the cited references fail to disclose, teach or suggest each and every element of amended independent claims 1, 10 and 19. The Office Action acknowledges that Burwell fails to disclose “if said transmitter address of said packet input from said ATM network and information about said transmission path through which said packet had been transmitted are matched with said transmitter address of said packet learnt by said second learning unit and information about said transmission path to which said packet is to be output, to scrap said packet.” See p. 3 of Office Action. To cure the deficiencies of Burwell the Office Action relies on Rodrig.

However, the combination of the cited references fail to identically disclose that “when a packet is transmitted by a broadcast method from a first device on said layer 2 network side to a device on said ATM network side, a loop-back transmission mode is set to said packet to be received by a second device on said ATM network side” as claimed in the amended independent claims. The Office Action asserts that the above-mentioned limitations are disclosed in Col. 3, lines 11-25 of Burwell. Applicants respectfully disagree.

The passage cited in the Office Action explains that user devices can be connected over an ATM network using existing LAN adapters. The cited passage does not concern

transmitting a packet via “a broadcast method from a first device on said layer 2 network side to a device on said ATM network side” as claimed. In addition, the cited passage does not disclose, teach or suggest setting “a loop-back transmission mode...to said packet to be received by a second device on said ATM network side” as claimed. Instead, the passages relied on in Burwell generally describe how user devices communicate over an ATM network using existing LAN adapters. Since the Federal Circuit has stated that “obviousness requires a suggestion of all limitations in a claim,” Applicant respectfully submits that the Examiner has not properly set forth a *prima facie* case of obviousness. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). (Emphasis added). Accordingly, the cited references fail to identically disclose, teach or suggest all the claim limitations as claimed in amended claims 1, 10 and 19.

When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Here, the cited references fail to disclose each and every limitation in as complete detail as is contained in amended independent claims 1, 10 and 19.

Claims 3-5, 7-9, 12-14, 16-18, 21-23 and 25-27 depend from one of independent claims 1, 10 or 19 and should be allowed for the reasons set forth above without regard to further patentable limitations contained therein.

If this rejection of the claims is maintained, the examiner is respectfully requested to point out where the above-mentioned features are disclosed in the cited references.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 6/3/09

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